REMARKS

Claim 1-20 are currently pending, wherein claims 1, 9, 13 and 20 have been amended to even more clearly define the invention. Favorable reconsideration is respectfully requested in view of the above-identified amendments and the remarks presented herein below.

In paragraph 1, the Office Action rejects claims 1-12 under 35 U.S.C. §101 as allegedly being non-statutory. Applicant respectfully traverses this rejection.

In rejecting claims 1-12, the Office Action asserts that the claims are general abstractions that fail to fall within the technological arts by being useful in the sense that computer-implemented methods are useful. Applicant respectfully disagrees.

The present invention is directed towards the acquiring of data, corresponding to patents for example, across various databases and the display of that data in a manner that aids in determining the strength or value of the patent or a group of patents, as related to other patents. To accomplish these tasks, patent data is acquired from various bibliographical databases based on a parameter file(s), grouped into at least one category, and stored in internal databases. A user can then select a desired category for display and the records corresponding to the selected categories are retrieved and displayed. Accordingly, the present invention as recited in claims 1-12 meets the requirements of 35 U.S.C. §101 because the claimed invention is not merely directed to an abstract idea, such as a mathematical formula, Rather, the claimed subject matter is within the technological arts and produces a "useful, concrete and tangible result." *State Street Bank & Trust Co. v Signature Finacial Group Inc.* 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998) For instance, the last step of claim 1 recites "displaying the records by the selected categories." Accordingly, Applicant

respectfully request reconsideration and withdrawal of the rejection of claims 1-20 under 35 U.S.C. §101.

In paragraph 2 (first occurrence), the Office Action rejects claims 1-9, 11, 12 and 20 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,721,910 to Unger et al. ("Unger"). Applicant respectfully traverses this rejection.

As discussed above, the invention provides a method and system for acquiring data, corresponding to patents, across various databases and displaying the data in a manner that aids in determining the strength or value of a patent or group of patents, as related to other patents. Accordingly, independent claim 1 defines a method for managing data that, as amended, includes, among other things, the steps of creating a parameter file; establishing a link with a database; and importing bibliographic data from the database based on the parameter file. In addition, the imported data is sorted and grouped into at least one category and stored in at least one internal database. The categorized data can then be retrieved and displayed based on user selected categories.

Unger discloses a multi-dimensional database that models a scientific or technical body of work. The database system of Unger contains a hierarchical model of a complex business, scientific or technical entity and the associated technical documents which reflect each aspect of the model. The database disaggregates the set of technical documents associated with the business or entity into discrete technical categories by use of a set of predefined search protocols which match the scientific or technical concepts within the model. The predefined search strategies automatically categorize the set of technical documents to fit the multidimensional hierarchical model of the scientific or business discipline. The

categorization may then be used by a relational database to identify trends and discontinuities in the research efforts represented by the documents. However, Unger fails to anticipate the present invention.

It is well known that in order to support a rejection under 35 U.S.C. §102, the cited reference must teach each and every claimed element. In the present case, Unger fails to anticipate independent claim 1 for at least the reason that Unger fails to disclose the steps of creating a parameter file and importing bibliographic data from a linked database based on the parameter file. While the parameter file was original cited in claim 9, the Office Action failed to address these added limitation. Accordingly, should the Examiner maintain his rejection of in view of Unger, Applicant respectfully requests that the Examiner point out by column and line number where Unger discloses the claimed parameter file.

Claims 2-9, 11 and 12 variously depend from independent claim 1. In addition, independent claim 20 defines a program product that includes, among other things, executable code for creating a parameter file and importing bibliographic data from a linked database based on the parameter file. Therefore, claims 2-9, 11, 12 and 20 are patentably distinguishable over Unger for at least those reasons presented above with respect to claim 1. Accordingly, Applicant respectfully request reconsideration and withdrawal of the rejection of claims 1-9, 11, 12 and 20 under 35 U.S.C. §102.

In paragraph 2 (second occurrence), the Office Action rejects claims 10 and 13-19 under 35 U.S.C. §103(a) as allegedly being unpatentable over Unger. Applicant respectfully traverses this rejection.

It is well known that in order to support a rejection under 35 U.S.C. §103, three basic criteria must be met. First, there must be some motivation to combine or modify the applied reference(s). Second, there must be a reasonable expectation of success. Finally, the combination/modification must disclose or suggest each and every claimed element. In the present case, claims 10 and 13-19 are not properly rejected under 35 U.S.C. §103 for at least the reason that the Office Action fails to met the required criteria as discussed below.

In rejecting claims 10 and 16, the Office Action asserts that although Unger fails to disclose that the "data is *displayed* as a spreadsheet", it would have been obvious to one skilled to in the art to provide such a display because it is efficient to display data in a form in which it has been explicitly organized. Furthermore, the Office Action asserts that the "lack of such a display would tend to defeat the purpose of a spreadsheet, which is bound to its display." These assertions are unfounded for the following reason.

Claims 10 and 16 each recite, among other things, that the retrieved records are displayed in a spreadsheet format *in accordance with a user's preference selection.* Therefore, even if one skilled in the art were motivated to display data as a spreadsheet, such a display would not in and of itself anticipate dependent claim 10. Displaying data in accordance with a user's preference selection does not explicitly or implicitly flow from displaying data as a spreadsheet. Nowhere in Unger is there any disclosure or suggestion of displaying data in accordance with a user's preference selection. Therefore, claim 10 is patentably distinguishable over Unger.

Claim 13 defines a system for acquiring and presenting data. The system includes, among other things, a computer for establishing a link with a database and importing data

from the database, a memory that stores the imported data in various groupings and categories, and a selection component that allows a user to select particular data of a record and the format of the data for display. In rejecting claim 13, the Office Action asserts that it would have been obvious to one skilled in the art to use an internal parameter as a common link. However, the Office Action does not address the fact that Unger fails to disclose a selection component that allows a user to select particular data of record and the format of the data for display. Accordingly, should the Examiner maintain this rejection is a future Office Action, Applicant requests that the Examiner point out by column and line number where the selection component as claimed is disclosed in Unger.

Claim 18, which depends from dependent claim 13, recites that a user can mark the imported data with an indication of priority. In rejecting claim 18, Office Action asserts that "patents themselves include priority data." However, the fact that patents may include "priority data" is not germane to the limitation of claim 18 inasmuch as claim 18 recites that a user can prioritize the imported data, not that the data includes priority information with regard to patents. Therefore, the fact that patents contain priority data is not sufficient to overcome the deficiencies of Unger.

Claim 19, which depends from independent claim 13, recites that the imported data includes the number of references cited to a patent. In rejecting claim 13, the Office Action asserts that patents themselves include the references cited and the "references that cite a patent can be retrieved by well known commands in patent search engines." However, nowhere in Unger is there any disclosure or suggestion of retrieving the references cited by a

patent, nor does the Office Action provide any motivation for modifying Unger to include such a feature.

As discussed in section 2143.01 of the MPEP, the mere fact that a reference can be modified does not render the resultant modification obvious unless the prior art also suggests the desirability of the modification. In view of the fact that neither the Office Action nor Unger suggest the desirability of including the number of references cited to a patent in the imported data, the mere statement that retrieving the references cited by a patent is well known is not enough to establish a *prime facie* case of obviousness. Therefore, claim 19 is patentably distinguishable over Unger.

Claims 14-17 depend from independent claim 13. Therefore, claims 14-17 are patentably distinguishable over Unger for at least those reasons presented above with respect to claim 13. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 10 and 13-19 under 35 U.S.C. §103.

This application is in condition for allowance. Notice of same is earnestly solicited. Should the Examiner have any questions regarding this application the Examiner is invited to call the undersigned at the number provided below.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: ____August 29, 2003____

By:____Penny L. Caudle____
       Penny L. Caudle
       Registration No. 46,607

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620